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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,771	11/12/2003	Patrick John Osborne	58644-0005	4367
24633 7590 01/17/2007 HOGAN & HARTSON LLP IP GROUP, COLUMBIA SQUARE 555 THIRTEENTH STREET, N.W. WASHINGTON, DC 20004			EXAMINER LEWIS, ALICIA M	
			ART UNIT 2164	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/17/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/705,771

Applicant(s)

OSBORNE ET AL.

Examiner

Alicia M. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4,6,7,9,10,12,13,15,16 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,7,9,10,12,13,15,16 and 18-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**SAM RIMELL**  
PRIMARY EXAMINER

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This office action is responsive to communication filed October 18, 2006. Claims 1, 7 and 13 are currently amended; claims 2, 5, 8, 11, 14 and 17 have been cancelled; and claims 19-24 have been added. Therefore, claims 1, 3, 4, 6, 7, 9, 10, 12, 13, 15, 16 and 18-24 are pending in this application.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 3, 4, 6, 7, 9, 10, 12, 13, 15, 16 and 18-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 7 and 13, it is unclear as to what (who) is meant by the term "third-party." There is no mention of a first or second party in the claims, and it is not clear as to what (who) the first and second parties are.

Claims 3, 4, 6, 7, 10, 12, 15, 16 and 18-24 are rejected as being dependent upon a rejected base claim.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-4, 7, 9-10, 13, 15-16, 19, 21 and 23 are rejected under 35 U.S.C.

103(a) as being unpatentable over Lowensohn et al. (US Patent Application Publication 2004/0230809 A1) ('Lowensohn') in view of Engelhart (US Patent Application Publication 2005/0182717 A1).

With respect to claims 1, 7 and 13, Lowensohn teaches:

input means for accepting the biometric data (paragraph 123 lines 1-3), wherein said input means comprises: electronic data acceptance means for receiving and accepting electronically stored biometric data (Figures 12 and 14B, paragraphs 126, 261 and 262), and physical data acceptance means for receiving physical biometric data and for converting said physical data to an electronic format for storage (Figures 12 and 14B, paragraph 38 lines 12-13, paragraph 123 lines 1-3);

quality check means for verifying that the biometric data conforms to a submission standard for processing by a third party (Figure 12, paragraph 80, paragraph 129 lines 1-3 and 13-18, paragraph 220);

communication means for sending the verified biometric data to the third-party for the processing and for accepting processing results (Figures 12 and 14B, paragraphs 124-125 and 261-262); and

database means for storing the verified biometric data and the processing results (Figure 5, Figures 12 and 14B, paragraphs 122 and 126, paragraph 220 lines 1-5).

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Although Lowensohn teaches that biometric data is transmitted, he does not explicitly state by what means the biometric data is accepted.

Engelhart teaches secure online purchasing (see abstract), in which he teaches electronic data acceptance means for receiving and accepting electronically stored biometric data (Figure 8, paragraph 38 lines 5-19).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Lowensohn by the teaching of Engelhart because electronic data acceptance means for receiving and accepting electronically stored biometric data would enable Lowensohn's system the enhanced capability to use the computer-based systems to securely purchase goods and services (Engelhart, paragraph 3 lines 1-3).

With respect to claims 3, 9 and 15, Lowensohn as modified teaches billing means for monitoring submissions and processing of data and for associating charges with said submissions and processing (Engelhart, paragraph 20, paragraph 21 lines 1-5, paragraph 22).

With respect to claims 4, 10 and 16, Lowensohn as modified teaches wherein said communication means sends the biometric data for processing after the billing means detects a sufficient balance for an associated submitter to pay for said charges (Engelhart, paragraph 22 lines 7-14).

With respect to claims 19, 21 and 23, Lowensohn as modified teaches wherein when the quality check means determines that the biometric data is not conforming to the submission standard, the input means acquires additional biometric data (Lowensohn, paragraphs 80-81, paragraph 84 lines 12-22, paragraph 129).

5. Claims 6, 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowensohn et al. (US Patent Application Publication 2004/0230809 A1) ('Lowensohn') in view of Engelhart (US Patent Application Publication 2005/0182717 A1), as applied to claims 1, 3-4, 7, 9-10, 13, 15-16, 19, 21 and 23 above, and further in view of McClurg et al. (US Patent 6,886,104 B1) ('McClurg').

With respect to claims 6, 12 and 18, Lowensohn as modified teaches claims 1, 7 and 13.

Lowensohn as modified does not teach whereby said submission standard is Electronic Fingerprint Transmission Specification (EFTS).

McClurg teaches a rechargeable mobile hand-held fingerprint scanner with a data and power communication interface (see abstract), in which he teaches whereby said submission standard is Electronic Fingerprint Transmission Specification (EFTS) (column 6 lines 39-40 and 47-49).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have further modified Lowensohn by the teaching of McClurg because whereby said submission standard is Electronic Fingerprint Transmission

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Specification (EFTS) would enable better quality fingerprints (McClurg, column 6 lines 39-40 and 47-49).

6. Claims 20, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowensohn et al. (US Patent Application Publication 2004/0230809 A1) ('Lowensohn') in view of Engelhart (US Patent Application Publication 2005/0182717 A1), as applied to claims 1, 3-4, 7, 9-10, 13, 15-16, 19, 21 and 23 above, and further in view of Kyle (US Patent Application Publication 2003/0215114 A1).

With respect to claims 20, 22 and 24, Lowensohn as modified teaches claims 1, 7 and 13.

Lowensohn as modified does not teach wherein the biometric data is for a potential airport employee.

Kyle teaches an identity verification system (see abstract), in which he teaches wherein the biometric data is for a potential airport employee (paragraph 91).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified further Lowensohn by the teaching of Kyle because wherein the biometric data is for a potential airport employee would enable a linkage of face recognition systems with personal identifier data for customer/employee verification, and would enable linkage of multiple data input devices, data output devices, cameras and other electronic components to a single processor to facilitate the identity verification process.

***Response to Arguments***

7. Applicant's arguments filed October 18, 2006 have been fully considered but they are not persuasive. Regarding claims 1, 7 and 13, Applicant argues that Lowensohn does not teach verifying that biometric data is in an appropriate submission standard for processing by a third party. Examiner disagrees. Lowensohn teaches that if any data is found to be invalid, the administrator is prompted to correct the entry (paragraph 81), and also that biometric data is verified to check quality (paragraph 123) before being processed by other parties. Applicant has not defined what (who) is meant by the term "third-party," thus any party reads on the claim.

8. Applicant further argues that the communication means does not relate to forwarding the biometric data to a third party for processing or to receive the processing results from the third party. Examiner disagrees. Lowensohn teaches in Figures 12 and 14B that biometric data is sent to other (third) parties for processing.

9. Applicant also argues that Lowensohn does not teach the storage of biometric processing results from a third party. Although the claims do not specifically recite who the processing results are from or what is meant by "third party", Lowensohn nonetheless teaches storage of biometric data and processing results from other (third parties) as can be seen in Figures 12 and 14B.

10. In response to applicant's argument that Engelhart is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant

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was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references are in the field of applicants' endeavor, processing of biometric data.

11. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

12. Applicant further argues that Engelhart does not teach limiting the transfer of data based upon a determination of sufficiency of funds. Examiner disagrees. Engelhart teaches in paragraph 22 that the fund guardian verifies that sufficient funds are available to satisfy the transaction.

13. Regarding Applicant's argument that Lowensohn does not teach converting physical biometric data into an electronic format, Examiner disagrees. Lowensohn teaches (in paragraph 123 and Figure 12) that biometric data is collected and stored in electronic format.

14. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

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(i.e., verifying that a stored fingerprint record complies with the EFTS for purposes of submission to a third party for processing) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### **Conclusion**

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia M. Lewis whose telephone number is 571-272-5599. The examiner can normally be reached on Monday - Friday, 9 - 6:30, alternate Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on 571-272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alicia Lewis  
January 4, 2007

  
**SAM RIMELL**  
PRIMARY EXAMINER